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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,537	12/15/1999	JOHN C. ROYER	4216.260-US	3928

25907 7590 01/14/2003

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EXAMINER

MARVICH, MARIA

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 01/14/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,537

Applicant(s)

ROYER ET AL.

Examiner

Maria B Marvich, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

This Office action is in response to the amendment filed 10/29/02.

Claims 26-28 are pending in the application. Claims 23-25 have been canceled.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 26 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,060,305. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claim 28 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,060,305. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claim would have been anticipated by claim 1 of the 6,060,305 patent. In other words, claim 1 falls entirely within the scope of claim 28. Specifically, both the claims in the 6,060,305 patent and the instant claims recite a recombinant *Fusarium venenatum* host cell of ATCC 20334 comprising a nucleic acid encoding a heterologous protein and a method for producing a heterologous protein.

Claims 26-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 29 of U.S. Patent No. 6,180,366. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 26-28 of the instant application are anticipated by claims 5 and 29 of 6,180,366. In other words, claims 5 and 29 fall entirely within the scope of claims 26-28. Specifically, both the claims in the 6,180,366 patent and the instant claims recite a recombinant *Fusarium venenatum* host cell of ATCC 20334 comprising a nucleic acid encoding a heterologous protein and a method for producing a heterologous protein.

Claims 26-28 directed to an invention not patentably distinct from claims 5 and 29 of commonly assigned U.S. Patent No. 6,180,366. Specifically, both the claims in the 6,180,366 patent and the instant claims recite a recombinant *Fusarium venenatum* host cell of ATCC 20334

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comprising a nucleic acid encoding a heterologous protein and a method for producing a heterologous protein.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned U.S. Patent No. 6,180,366, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim 27 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 100 of copending Application No. 09/482,788. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 100 of the copending application anticipates claims 27 of the

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instant application. Claim 100 falls entirely within the scope of claim 27. Specifically, both claims recite a method for producing a heterologous protein and a recombinant *Fusarium venenatum* host cell of ATCC 20334 comprising a nucleic acid encoding a heterologous protein. Additionally, if a patent resulting from the instant claims was issued and transferred to an assignee different from the assignee holding a patent from 09/482,788, then two different assignees would hold a patent to the claimed invention of 09/482,788, and thus improperly there would be possible harassment by multiple assignees.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 27 is directed to an invention not patentably distinct from claim 100 of commonly assigned 09/482,788. Specifically, both claims recite a method for producing a heterologous protein and a recombinant *Fusarium venenatum* host cell of ATCC 20334 comprising a nucleic acid encoding a heterologous protein.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 09/482,788, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to

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name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Response to Arguments

Applicants traverse the 112, first paragraph rejection of claims 23-25 on pages 2-7 of paper number 12. Cancellation of claims 23-25 and addition of claims 26-28 renders applicants' arguments directed against the rejection made against cancelled claims 23-25 moot. The non-deposit related 112, first paragraph, rejections are withdrawn.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claim 23-25 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants traverse the 112, first paragraph, Written Deposit rejection of claims 23-25 on pages 6-7. Applicant traverses the rejection that a written deposit is required as the cells are known and readily available. Applicant find support in 37 CFR 1.802(b).

The rejection under 112, first paragraph stands. In *Ex parte Humphreys*, 24 USPQ2d 1255 (BD. Pat. App. & Int. 1992), it was found that the only manner in which applicants could satisfy their burden of assuring public access to the needed biological material was by making a deposit as the ability to obtain the material from a given depository prior to and after issuance of a patent did not insure that upon issuance of a patent that such material would continue to be accessible to the public. See MPEP 2404.01. CFR 1.802(b) states that public access during the term of the patent may affect the enforceability of the patent. In order to ensure that the cells are available for the life of the patent, the applicant must satisfy the deposit requirement under 37 CFR 1.801-1.809.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B Marvich, PhD whose telephone number is (703) 605-1207. The examiner can normally be reached on M-F (6:30-3:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3291.

Maria B Marvich, PhD
Examiner
Art Unit 1636

January 13, 2003

DAVID GUZO
PRIMARY EXAMINER
